Remarks

The Applicant has amended paragraph 15 of the Specification. The Applicant respectfully submits that no new matter has been added. Support for these amendments may be found in the originally filed Claims 1-4 and 8-9, Abstract lines 9-11, and FIGS. 1 and 2.

The Examiner has rejected claims 1-10 under 35 U.S.C. 112 as failing to comply with the written description requirement. The Examiner has also rejected claims 1-10 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,987,464 to Schneider ("the '464 patent") in view of U.S. Patent No. 6,766,305 to Fucarile et al. ("the '305 patent"). These rejections are respectfully traversed.

35 U.S.C. 112 Rejection:

The Examiner stated that "recordation form" was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. The Applicant respectfully disagrees.

Claim 1, as originally filed, includes "at least one database containing a plurality of recordation forms accessible by said Internet server" and software "for querying said database of recordation forms to retrieve <u>a recordation form corresponding to said transfer request</u>" and "for <u>combining</u> the retrieved information record with <u>the retrieved recordation form</u> to generate a document." (Applicant's Claim 1). Claims 3 and 8, as previously amended to correct a typographical error, include "each recordation form including an intellectual property type identifier and a jurisdiction identifier." Applicant's Claims 3 & 8).

Figures 1 and 2 show a database of <u>"transfer forms" 36</u>. The original Specification describes how "Upon receiving said information 16 from the client 10, the TAS 20

queries a <u>database of documents 36</u> for <u>documents necessary to complete said trans-fer.</u>" (Original Specification, Para. 15). The Specification further describes how "the TAS 20 <u>combines said necessary documents</u> with said necessary intellectual property information records and said transaction information." (Original Specification, Para. 15).

The Specification describes transferring intellectual property and the practice of recording "the transfers with the appropriate intellectual property offices around the world." (Applicant's Specification, Para. 3). For background purposes, the Specification also includes a description of known electronic forms "for assembly with client data to automate the preparation, prosecution, issue and maintenance of patents and trade-marks" offered by Perfectlaw™ DocPro™ by Executive Data Systems, Inc, of Coral Ga-bles, FL. (Applicant's Specification, Para. 6).

The "database containing a plurality of recordation forms" of the present inven-tion may therefore include any forms required to be filed with the appropriate intellectual property offices to record a property transfer. In some embodiments, a recordation form may include an intellectual property type identifier and jurisdiction identifier to identify the particular intellectual property type(s) and jurisdiction(s) for which the form is appli-cable.

The Applicant has amended Paragraph 15 of the Specification to include corre-sponding language from the claims and Figures to further clarify the subject matter "recordation form." The Applicant respectfully submits that Claims 1-10 comply with the written description requirement.

35 U.S. C. 103(a) Rejection:

As the Examiner correctly points out, the '464 patent fails to disclose at least one database containing a plurality of recordation forms accessible by said Internet server and software executing on said Internet server for querying a database of information records to retrieve an information record corresponding to a transfer request, for query-

ing a database of recordation forms to retrieve a recordation form corresponding to said transfer request, and for combining the retrieved information record with the retrieved recordation form to generate a document as required by all pending claims. The '305 patent fails to provide the missing disclosure of the '464 patent, thus no combination thereof can render any claim of the present application obvious.

The '305 patent teaches a licensing method and system for licensing content and access to functions provided by plug-in, application, applet or any client software operating in a computer. (col. 3, lines 2-5). The invention facilitates the distribution of revenue and non-revenue generating content on the Internet. (col. 3, lines 5-7). The invention is carried out by including a plug-in or application running on each user's computer which scans content accessed by the user for a special licensing form. (col. 3, 34-38). The special form, placed within the accessed content, contains either a legal assertion of the non-commercial nature of the use or an identification of the licensee and other related data. (Abstract). Access to the content is therefore controlled by the use of the special licensing form (300) that must be present in the content in order for access to be granted. (col. 5, lines 37-39; FIG. 3). To validate or obtain an explicit license to access the content, the user is required to contact an appropriate license server. (col. 3, lines 44-46).

Alternatively, the claims of the present application are directed toward a system for automating the transfer of property. (Applicant's Claims 1-10). Applications of the system include due diligence, transfer, and recording transfer of intellectual properties, e.g., pursuant to an acquisition, divestiture, merger, IPO, change of name or the like. (Applicant's Specification, Para. 2). Each of the Claims 1-10 require "at least one database containing a plurality of recordation forms." Claims 1-10 further require software "for querying said database of recordation forms to retrieve a recordation form corresponding to said" "transfer request" or "property transfer request" and "for combining the

retrieved information record with the retrieved recordation form to generate" "a document" or "transfer document."

The Examiner states that database 406 in FIG. 4 of the '305 patent, and corresponding text, teaches a database containing a plurality of recordation forms accessible by said Internet server. (Office Action, Page 4). However, the database 406 (and 406(a)) includes only information to validate or invalidate an explicit license to access content and to generate a response to a user. (col. 9, lines 12-22; col. 13, lines 62-67). As taught by the '305 patent, a plug-in 103 on a user computer 100 scans content 201 accessed by the user computer for a license form (300) and interprets the license form. (col. 9, lines 3-6). The plug-in on the user computer then causes a request for license validation to be generated based in part on the content of the license form. (col. 9, lines 12-15). The license, or access to the content, is then validated or invalidated depending upon information in the request and the database 406. (col. 11, lines 37-38; col. 9, lines 20-22). Thus, the database 406 is not a database of recordation forms as required by all claims of the present invention.

Moreover, the license form 300 taught by the '305 patent is not at all analogous to a recordation form. The form 300 is a code found in accessed content or software. For example, "the {License...} form 300 may look like: {License by XYZ Computer Corporation "101010110010010101001000010001001"}." (col. 8, lines 45-47). The form 300 merely conveys information about particular content, such as the identity of licensees of the content or a legal assertion of the non-commercial nature of the content's use. (Abstract; col. 8, lines 48-51; FIG. 3).
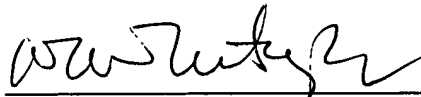
Therefore, nowhere does the '305 patent teach or suggest, in FIG. 4 or elsewhere, a database of recordation forms as required by all claims of the present invention. The Applicant respectfully submits that since neither the '464 patent nor the '305 patent teach, disclose or suggest a database containing a plurality of recordation forms

as required by all the claims of the present application, no combination thereof can render any claim of the present application obvious.

Finally, it is well settled that the mere fact that references can be modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). In the present case, there is absolutely no suggestion in the prior art to modify the database 406 of the '305 patent to include recordation forms. The database 406 includes information necessary to validate information in order to grant or deny access to particular content or software. The invention taught by the '305 patent would thus be rendered unsatisfactory if database 406 instead included recordation forms for the transfer of property.

For the foregoing reasons, it is respectfully submitted that claims 1 – 10, all of the claims remaining in the application, are in order for allowance and early notice to that effect is respectfully requested.

Respectfully submitted,

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